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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,387	02/10/2004	Scott V. Taylor	AUS-2265-AL	3912
21378 7590 12/10/2008 APPLIED MEDICAL RESOURCES CORPORATION 22872 Avenida Empresa Rancho Santa Margarita, CA 92688				
EXAMINER NGUYEN, TUAN VAN				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
12/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/776,387

**Applicant(s)**

TAYLOR ET AL.

**Examiner**

TUAN V. NGUYEN

**Art Unit**

3731

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-63 and 67 is/are pending in the application.
- 4a) Of the above claim(s) 6, 10, 11, 13, 14, 26-30, 32-46, 49-53, 55-63 and 67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 12, 15-25, 31, 47, 48, 54 and 64-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/17/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. In previous Office action, claims 1-5, 7-9, 12, 15-25, 31, 47, 48, 54 and 64-66 were examined and rejected and claims 6, 10, 11, 13, 14, 26-30, 32-42, 43-46, 49-53, and 55-63 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 17, 2008 has been entered.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. **Claims 1-5, 7-9, 12, 15, 17-18, 21-25, 31, 47, 48, and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentelia et al. (U.S. 5,201,714) in view of Sleister et al (US 5,522,831).**
6. Gentelia discloses (Figs. 1 and 4) a trocar comprising: a cannula having a proximal end and a distal end; a seal housing communicating with the cannula to define a working channel; a seal assembly disposed within the seal housing; and at least one roller included in the seal assembly and having an axle supported by the seal housing. Gentelia discloses the invention substantially as claimed except for the roller is a conformable roller that is dimensioned and configured for forming a tight seal in the absence of an instrument extending therethrough and for contacting with and conforming to an instrument thereby forming an instrument seal in the presence of the instrument extending therethrough. However, Sleister discloses (Figs. 7-9) in order to maintain sufficient pressure against the instrument to prevent gas leakage, the surface of the dynamic seal member of a trocar device must be made from a single elastomer or combination of elastomers (col. 8, lines

39-44). Therefore, it would have been obvious to use the teaching of Sleister to improve the rollers of Gentilia by adding an elastomeric layer to the outside surface of the rollers to provide the sealing with or without presence of the instrument, thus, improving the efficacy of the device.

7. Referring to claim **23**, Gravener discloses the invention substantially as claimed except for the housing and the roller are formed of translucent material. However, it is old and well known in the art that trocar housing and cannula are formed of translucent or transparent material is for the purpose of providing the surgeons the ability to observe the tissue and the location of the distal tip of the instrument being inserted into the cavity. Extrinsic evidence, Frederick et al (US 6,017,356) discloses the trocar 40 is made from transparent material for the purpose of providing the surgeons the ability to observe the tissue (see Example 2).
8. **Claims 16, 19, 20, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gentilia et al. and Sleister et al as applied to claims in view of De la Torre et al (US . 6,238,373).**
9. Gentilia as modified by Sleister discloses the invention substantially as claimed except for the resilient material is a gel material. However, De la Torre discloses such a material for his device (see col. 10, line 52 to col. 11, line 15 and Fig. 16-16a). Apparently the gel material provides a better compliant between the valve and the outer surface of the instrument thereby providing a better seal between the valve and the instrument. Therefore, it would have been obvious to one of

ordinary skill in the art to include the gel material around the rollers of the modified device of Gentilia so that it too would have the same advantage.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./  
Examiner, Art Unit 3731

/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3731